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| H. Duane Switzer, Jones Day | | | FOOTLAND, LENARD A | |
| North Point | | | ART UNIT | |
| 901 Lakeside Avenue | | | PAPER NUMBER | |
| Cleveland, OH 44114-1190 | | | 3682 | |

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/784,459
Filing Date: February 23, 2004
Appellant(s): WEBB ET AL.

H. Duane Switzer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed March 29, 2006 appealing from the
Office action mailed October 31, 2005.¹

¹ There was some mail communication between the examiner and attorney Switzer regarding the propriety of filing an appeal under the circumstances in question. Upon consultation, it was determined by the examiner that the filing was proper, and attorney Switzer was notified thereof by phone.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim(s) 61-76 and 80-81 are rejected under 35 U.S.C. § 112, second paragraphs, for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The rejection under paragraph 1 is withdrawn.

These claims calling overall for a final product with a "formed end" include commingled replete therein limitations regarding a "preform" that in many cases makes confused and unclear what actual limitations of the final product are being claimed.

For example, claim 61 has the deformable end portion decreasing toward its outer end (note also that claiming in parentheses [between ...] is not permissible); claim 70 has the end portion decreasing in thickness also; and claim 80 has the same. All claims should be reviewed to be purged of all reference to the preform.

Claim(s) 61-76, 80-81, to the extent understood are rejected under 35 U.S.C. § 102(e), as being anticipated by Hofmann et al. ("Hofmann").

Hofmann disclose all of the claimed elements, as understood, including, for example, an "inner beveled edge" near beta of the front fig., and the "deformable end portion" having a cylindrical outer surface and an "inner [vertical] face".

Considering claim 61, and making reference to attached exhibit "A" (a marked-up copy of fig. 3 of Hofmann [on front page]), and exhibits "B" and "C" (marked up copies of

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appellants' fig's. 3 and 4; and fig. 1, respectively) the indefiniteness of claim 61 and extent to which Hofmann reads upon the finished product may be considered. Because of the detail involved, and the necessity of description of some features with explanatory markings, reference to these exhibits is suggested as opposed to the unmarked figures.

Claim 61 calls for a "spindle" 14 having a "component" 26 (inner race) "secured thereto by a formed end" 20. (Note that appellants' fig. 3 formed end, which is the same as that in fig. 1, appears to differ slightly in shape. This is put down to the fact that fig. 1's formed end is illustrated in smaller form which would make complete detail more difficult; therefore references to the more detailed and referenced fig. 3 will control, there being no confusion as to the appellants' intent in this regard.) Unless otherwise indicated, all references to Hofmann will be to marked-up fig. 3.

The "formed end" makes clear that the claim refers to the finished product of fig. 3 as opposed to the undeformed perform of fig. 4. Hofmann fig. 3 shows a spindle and component secured by a formed end.

Claim 61 calls for the component having a cylindrical opening (obviously filled by the spindle, as finished) and outer face which Hofmann also has.

Claim 61 then calls for a "spindle outer surface ... and ... deformable end portion (71) with an outer end (78)", which is where the trouble begins because we are now talking about the perform of fig. 4, which is not present in the finished product, contradicts the finished product, and the detailed particulars of which in their transmuted finished form (e.g. end 78) can only be guessed at. "As understood", preform features

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not present or clear in the finished product will therefore be disregarded in terms of the art rejection.

The claimed spindle has a beveled surface 68 inclined inwardly from the end – see marked area of Hofmann.

Then is claimed a “deformable ... end portion (71) [with] tapered inner surface (72, 74) [etc.]” which brings us back to the contradictory perform, but does state that the now unidentifiable preform material is formed into a “single curved outside surface ... on the formed end that faces outwardly generally axially of the spindle axis and curves smoothly along its length toward the ... axis from the peripheral outside corner ... of the formed end ... that is located closely adjacent the outer face of the component (26)”.

The claim later goes on to say that the said “curved outside surface ... moves both axially outwardly and radially inwardly.”

Hofmann shows such a single curved outside surface ... [that] curves smoothly from the marked “peripheral outside corner” ... mov[ing] both axially outwardly and radially inwardly.

Hofmann’s single curved surface curving smoothly from the marked “marked peripheral outside corner (being the point at which the marked “straight surface A” intersects the marked “single curved outside surface”) curving “axially outwardly and radially inwardly” to the marked “point of maximum axial outer extent of the formed end.”

It is true that in Hofmann the curve continues axially inwardly from that point, but Hofmann’s indicated smoothly curving surface is the only one that “moves axially outwardly.” A careful inspection of Hofmann will show that that for a short distance the

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curved outside surface of the formed end starts its curve while it is still moving outwardly and then, after reaching its maximum outward point, starts curving axially inwardly. Note that appellants' fig. 3 also shows a marked "second curved surface" where surface 62 transitions to surface 66.

Claim 61 continues that "the thickness of the formed end in a direction axially of the ... axis gradually increases along its length generally radially ... from the peripheral outside corner ... toward the ... axis. In other words, the formed end gets thicker as it moves radially inwardly.

A perusal of Hofmann's formed end shows this also to be the case.

The rejections of the other independent claims rejected is similar.

(10) Response to Argument

At page 10, appellants argue that the use of word phraseology in parentheses is not indefinite.

While it is clear that reference characters in parentheses (without patentable weight) is acceptable, that explicit approval does not extend to claim wording. It is the examiner's position that that the use of wording in parentheses is indefinite in that makes unclear whether or not the wording in parentheses is given full patentable weight.

At pages 11 and 12, the appellants argue that including perform (intermediate product claim terminology) in a final product claim is not indefinite or confusing. As the rejection analysis set forth above shows, it is certainly in this instance confusing and unclear, and does not set forth the metes and bounds of the claimed invention.

It may or may not be the case that in certain instances a passing reference to intermediate language structure may not be confusing in terms of what is being claimed in the final product – that it may be in effect the equivalent of product-by-process language that may be disregarded as mere surplusage – and therefore may not be confusing.

But that is not the case here. The language of the intermediate product preform is so extensive and so commingled with final product language that it renders the claims incomprehensible.

The appellants obviously intend that the intermediate product language should be considered part of the definitely claimed language of the claim, since they argue strenuously that they do not wish that language removed, so the claims are left with commingled intermediate and final product language that leaves unclear what is being claimed.

At pages 12-17, appellants argue the art rejection over Hofmann of various claim rejections.

That art rejection is “as understood”, namely, that the intermediate language in these claims so confuses the metes and bounds of the claims that the art rejection only applies to those parts of the claims that are clear, which is limited.

The examiner in the rejection analysis set forth above with regard to claim 61 has set forth exactly why, even in a very broad claim, it is very difficult to guess what appellants have in mind in terms of what they are claiming, assuming that they do subjectively have something in mind. Further analysis of such confused claim

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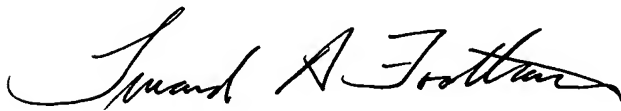
terminology is unnecessary and impractical. The art rejection is basically to give the Board the opportunity to inspect the best art relative to the claims.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

A handwritten signature in cursive script, reading "Lenard A. Footland".

Lenard A. Footland

Conferees:

Richard Ridley 

Thomas Hannon 

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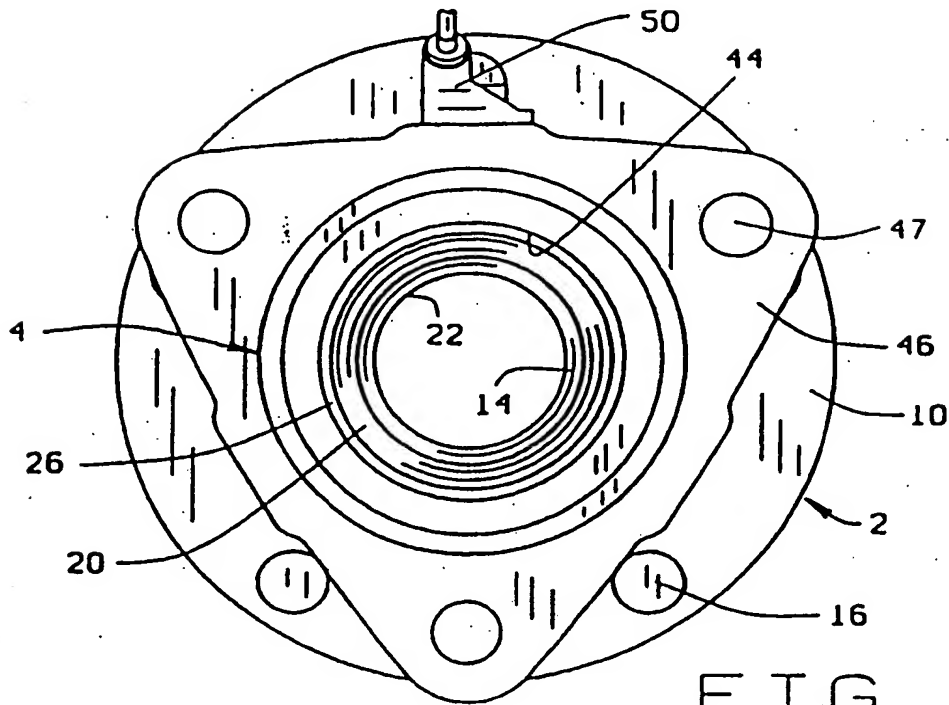


FIG. 2

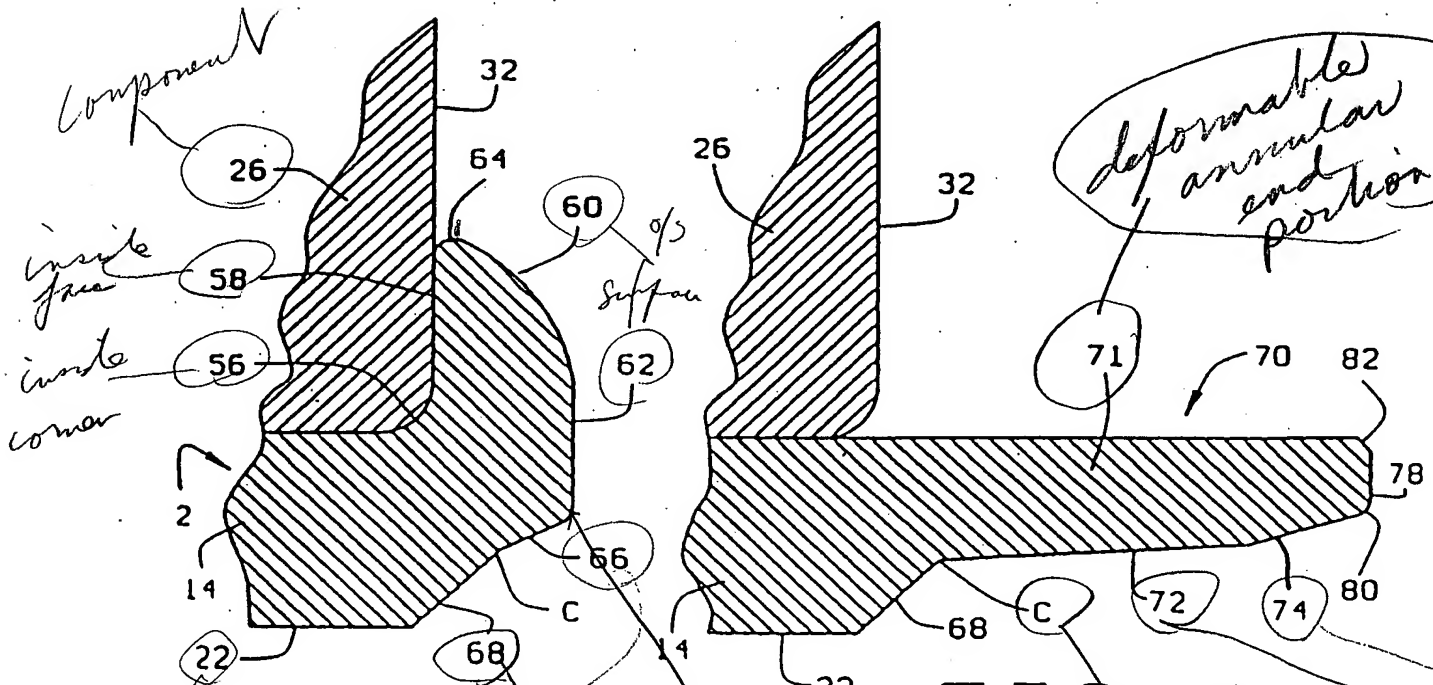


FIG. 3

FIG. 4

internal surface of spindle

outside transition

inner beveled surface (in preform)

"B"

intersection = layered surface